

REMARKS

In the Final Office Action¹, the Examiner took the following actions:

rejected claims 25 and 27 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite;

rejected claims 1-5, 9-14, and 17-22 under 35 U.S.C. § 103(a) as allegedly obvious in view of U.S. Patent Publication 2002/0059127 to Brown et al. ("Brown");

rejected claims 7, 8, 15, 16, and 23-26 under 35 U.S.C. § 103(a) as allegedly obvious over Brown in view of U.S. Patent Publication 2005/0262014 to Fickes ("Fickes")

rejected claim 27 under 35 U.S.C. § 103(a) as allegedly obvious over Brown in view of Fickes in further view of U.S. Patent Publication 2004/0158479 to Adhikari ("Adhikari"); and

rejected claim 28 under 35 U.S.C. § 103(a) as allegedly obvious over Brown in view of Fickes and Adhikari, in further view of Official Notice.

Claims 1-5 , 7-13, 15-21, 23-25, 27, and 28 are pending in this application.

Claims 1, 9, 17, and 23-25 are amended, while claims 14, 22, and 26 are cancelled.

Applicant submits no new matter is added by this Amendment.

Applicant thanks the Examiner for considering the Information Disclosure Statement filed August 4, 2005 and for returning a signed copy with the Advisory Action of September 23, 2008.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

In the Advisory Action, the Examiner did not state whether the rejections of claims 25 and 27 would be withdrawn in view of the proposed amendment submitted with the Amendment and Response filed August 29, 2008. Since the amendments to claims 25 and 27 were not entered, Applicant re-presents these amendments and the corresponding remarks in this paper.

Applicant respectfully traverses the rejection of claims 25 and 27 under 35 U.S.C. § 112 as allegedly indefinite. Claim 25 is amended in a manner consistent with that of the Examiner's interpretation of claim 25 in the Final Office Action. Thus, Applicant believes the rejection of claim 25 to be moot. With respect to claim 27, Applicant points out that claim 27 depends on claim 25. Claim 25 recites, in part, "wherein one action is displaying a calculated impairment price." Claim 27, due to its dependence on claim 25 therefore incorporates this feature and is not indefinite as the Office Action states. Accordingly, Applicant respectfully requests the Examiner withdraw the rejection of claims 25 and 27.

Applicant respectfully traverses the rejections of the claims under 35 U.S.C. § 103(a). A *prima facie* case of obviousness has not been established with respect to these claims. For example, Brown does not teach or suggest each and every feature of claim 1 as asserted by the Final Office Action.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A

conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2154. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. §2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Claim 1 recites, in part, “wherein the one or more actions are performed at some point before a sale or purchase of each object and are selected from a list comprising: displaying a calculated impairment price; sending a message to a person containing information about the specific condition in question; sending a list containing proposals for action to a person; presenting advice for a degree to which the conditions are

satisfied on a display; and performing a value adjustment for displaying each object in the accounting system.” Brown does not disclose or suggest at least this feature of claim 1.

The Examiner alleges that Brown discloses “automatically sending a message to a person [see at least 0053] depending upon the manner or degree to which one or more of the presettable conditions are satisfied [see at least 0047 and 0048]” (brackets original). Final Office Action at page 4. This allegation, however, is not correct.

The above identified portion of Brown states, in relevant part, “[i]n the preferred embodiment, communications between these various systems are provided through electronic communication ports coupled to each system. The communication links are preferably provided over a local area network, but could be provided via any type of modern connections, through wide area networks, via internet or email communication links, or through a number of different hard wired or wireless communication links.” Brown paragraph [0053].

General disclosure of “communication links” including “internet or email communication links” in Brown do not constitute the claimed “sending a message to a person containing information about the specific condition in question.” Indeed, nothing in the above cited portion of Brown, nor anywhere else in Brown, teaches or suggests this feature of claim 1 because Brown does not disclose any sending of “information about the specific condition in question”. Since Brown is directed to the “automatic manage[ment] of investment portfolios,” there exists no motivation or reason why one of ordinary skill in the art would modify Brown in the manner claimed. Brown abstract.

Since Brown does not disclose “sending a message to a person containing information about the specific condition in question,” contrary to the allegations made in the Final Office Action, the rejection of claim 1 is improper and should be withdrawn.

Notwithstanding the above with respect to claim 1, Brown also does not disclose or suggest the claimed “one or more actions are performed at some point before a sale or purchase of each object.”

Brown discloses “a method and apparatus for automatically managing investment portfolios is disclosed which substantially tracks a selected index and automatically harvests tax losses” (emphasis added). Brown abstract. Thus, it is clear from Brown that this apparatus operates automatically without the need for user input during the purchase and sale of securities. For example, Brown discloses “[t]he use of automatic tax loss harvesting and automatic rebalancing of the account minimizes the amount of human intervention required, thereby further reducing costs by reducing management fees, and reducing errors which can be introduced by the decisions of account managers.” Brown paragraph [0050].

Not only does Brown teach away from the claimed “actions” that involve a “person,” there is no reason why any of the claimed “actions” would be performed “at some point before a sale or purchase of each object” as claimed in claim 1 (emphasis added). Since Brown discloses that “human intervention” is not desirable for the Brown system, there is no reason why one of ordinary skill in the art would be motivated to modify Brown to involve a “person” in each “sale or purchase of each object,” as claimed in claim 1. This is especially true when the claimed “action” involving a

“person” is to take place “before a sale or purchase of each object” because such action is delayed by providing information a person. Therefore, one of ordinary skill in the art would not be motivated to modify Brown to perform an action “before a purchase or sale of an object,” such as the claimed “sending a message to a person containing information about the specific condition in question” because Brown teaches away from the use of “human intervention” in the “automatic” tax loss harvesting system disclosed. As such, a *prima facie* case of obviousness has not been established for claim 1 and the rejection of claim 1 should be withdrawn.

Independent claims 9, 17, and 25 contain features similar to those discussed in connection with claim 1. None of Fickes, Adhikari, or Official Notice remedy the deficiencies of Brown as outlined above. Applicant therefore asserts that these claims are allowable for at least similar reasons as claim 1. In instances where the Examiner has relied on Official Notice, Applicant requests the Examiner provide evidence of each and every assertion made in the Final Office Action.

The dependent claims are allowable for at least the same reasons as the independent claims from which these dependent claims depend. Applicant respectfully requests the Examiner withdraw the rejections of the claims under 35 U.S.C. 103 and allow the claims.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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